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EXAMINER	
ALLEN, WILLIAM J	
ART UNIT	**PAPER NUMBER**
3625	

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/774,372	CHURCH, CRAIG D.	
	Examiner	Art Unit	
	William J. Allen	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 32-41 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 32-41, when nonfunctional descriptive material is recorded on some computer-readable medium, either in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material (i.e. abstract ideas) stored in some computer readable medium, either in a computer or on an electromagnetic carrier signal, does not make it statutory. See Diehr, 450 U.S. at 185-86 USPQ at 8. A claimed signal does not itself have physical structure nor does a claimed signal perform any useful, concrete, or tangible result. Thereby, a signal, which is a form of energy and an abstract idea, does not fall within one of the four statutory classes of subject matter.

More particularly, independent claims 32 and 37 are directed to "a machine-readable medium having a plurality of instructions, for at least one processor, stored therein, wherein when the instructions are executed by the at least one processor, the at least one processor is configured to...". The specification, however, states a "computer-readable medium may include one or more memory devices and/or carrier waves" (see Specification, 0025). Because the

exemplary mediums include non-statutory subject matter, independent claims 32 and 37 as well as all dependent claims are thereby directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 8, 11-13, 18-24, 27, 29, 32-33, and 37-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Fano (US 6317718).

Regarding claim 1, Fano teaches a method for requesting and receiving item location information from a portable device, the method comprising:

establishing a session between the portable device and a server (see at least: abstract, col. 47 lines 20-24, Fig. 17);

sending, from the portable device to the server, a selection of at least one item; receiving the selection at the server (see at least: abstract, col. 1 lines 13-23, col. 47 lines 40-46);

accessing, by the server, location information regarding the at least one item; sending, by the server, the location information to the portable device; receiving, at the portable device, the location information from the server; and outputting, by the portable device, the location information (see at least: col. 47 lines 47-56, Fig. 27).

Regarding claims 12, 20, 27, 32, and 37, claims 1, 12, 20, 27, 32, 37 closely parallel claim 1 and are thereby rejected under the same rationale.

Regarding claims 8, 11, 13, 18-19, 21-24, 29, 33, and 38, Fano teaches:

(8) sending, by the server, a menu of items to the portable device; receiving and outputting, by the portable device, the menu of items; and selecting, by a user via the portable device, the at least one item from the output menu of items (see at least: col. 47 line 25-col. 48 line 26, Fig. 27).

(11) wherein the location information includes a location of each of the at least one selected item (see at least: col. 47 lines 47-56, Fig. 27).

(13) wherein the processing logic is further configured to: output, to the display, a menu of items received from the server, wherein the receiving the selection occurs as a result of the user selecting the at least one item from the displayed menu of items (see at least: col. 47 line 47-col. 48 line 26, Fig. 27).

(18) wherein the processing logic is further configured to send the selection of the at least one item to the server via an e-mail message (see at least: col. 32 line 60-col. 33 line 6).

(19) wherein the processing logic is configured to receive the location information about the at least one item from the server via an e-mail message (see at least: col. 32 line 60-col. 33 line 6).

The Examiner notes that the PDA is configured to send/receive emails.

(21) second processing logic, an input device connected to the second processing logic, a display connected to the second processing logic, and a wireless communication interface connected to the second processing logic, wherein: the second processing logic is configured to: receive an indication of at least one item from a user via the input device, send the indication of the at least one item to the server via the wireless communication interface, receive, via the wireless communication interface, the location information regarding the at least one item from the server, and output the location information on the display (see at least: col. 47 line 25-col. 48 line 26, Fig. 27).

(22) wherein the first processing logic is further configured to determine whether the device is at a particular site (see at least: col. 47 line 58-col. 48 line 26, Fig. 27). The Examiner notes that the system can determine if a store closest to a user has an item of interest and thereby determines whether a user is at a particular site.

(23) wherein the first processing logic is further configured to send an indication to the portable device indicating whether the portable device is located at a particular site (see at least: col. 47 line 58-col. 48 line 26, Fig. 27). The Examiner notes that displaying the particular items of interest indicates that the user is at a particular site.

(24) cause at least one menu to be displayed when the second processing logic determines that the device is not located at a particular site, and refrain from causing the at least one menu to be displayed when the second processing logic determines that the device is located at the particular site (see at least: col. 47 line 58-col. 48 line 26, Fig. 27). The Examiner notes that general merchandise (i.e. at least one menu) is displayed when the user is not at a particular site

and an specific items of interest are displayed when the user is at a particular site; thereby, the system refrains from showing general merchandise (i.e. the at least one menu).

(29) means for selecting a particular menu for display (see at least: col. 47 line 58-col. 48 line 26, Fig. 27).

(33) wherein the at least one processor is further configured to: receive, from the server, a menu of items located at a particular site, output the menu of items; and allow a user to select the at least one item from the menu of items (see at least: col. 47 line 25-col. 48 line 26, Fig. 27).

(38) send a menu of items located at a particular site to the device (see at least: col. 47 line 25-col. 48 line 26, Fig. 27).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fano in view of Official Notice.

Regarding claim 2, Fano teaches all of the above and further teaches accessing a wireless network using a PDA in a shopping mall setting. Fano further suggests the wireless device connecting directly to a server without the use of any special equipment at the shopping mall location (see at least: col. 47 lines 25-39). Fano, however, does not expressly teach *wherein the session is established via a direct wireless connection between the portable device and the server*. The Examiner takes Official Notice to establishing a direct wireless connection between the portable device and the server. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Fano to have included *wherein the session is established via a direct wireless connection between the portable device and the server* as taught Official Notice in order to provide a system that does not require any special equipment at the shopping location (see at least: Fano, col. 47 lines 25-39).

7. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano in view of Parkyn (US 20040215524).

Regarding claims 3-5, Fano teaches all of the above and teaches using a mobile wireless device (see at least: Fig. 17). Fano, however, does not expressly teach *wherein the session is established from the portable device to a wireless access device that establishes a connection to the server, where the connection between the wireless access device and the server is one of a WiFi connection and an optical connection,* and *wherein the connection between the wireless access device and the server is via a network to which the server is connected.* Parkyn teaches *wherein the session is established from the portable device to a wireless access device that establishes a connection to the server, where the connection between the wireless access device and the server is one of a WiFi connection and an optical connection,* and *wherein the connection between the wireless access device and the server is via a network to which the server is connected* (see at least: abstract, 0012, 0022, Fig. 2). The Examiner notes that a user connects to a WiFi network and then to the vendor system. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Fano to have included connecting to a wireless device that establishes a session with a server as taught by Parkyn in order to provide patrons located in wireless hotspots with easy network access using their wireless-enabled device (see at least: Parkyn, 0003).

8. Claims 6-7, 9, 34-35, and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano in view of Swartz et al. (US 6937998, herein referred to as Swartz).

Regarding claims 6, 9, 34, and 39, Fano teaches all of the above as noted and further teaches: *determining whether the portable device is located at a particular site; when the server determines that the portable device is located at the particular site: sending, by the server, a menu of items located at the particular site to the portable device, receiving and outputting, by the portable device, the menu of items, and selecting, by a user via the portable device, the at least one item from the menu of items at the particular site* (see at least: col. 47 line 58-col. 46 line 26).The Examiner notes that the system determines whether a user is at a particular site/store by determining if the store has items of interest to the user and displaying a menu of those items of interest. Additionally, when the server determines that the portable device is not located at the particular site (i.e. the store does not have items of interest), it displays stores in the vicinity of the portable device along with the merchandise they offer.

Fano also teaches *sending, from the server to the portable device, a menu of items located at the particular site, receiving and outputting, at the portable device, the menu of items located at the selected particular site,* (see at least: col. 47 line 58-col. 48 line 26, Fig. 27)) and *selecting, by a user via the portable device, the at least one item from the menu of items at the particular site* (note the user "selects" and item).

Fano, though teaching the presentation of additional and alternative stores to the user, Fano does not expressly teach *selecting, at the portable device by the user, one of the particular sites and sending an indication of the one of the particular sites to the server.* Swartz teaches

selecting, at the portable device by the user, one of the particular sites and sending an indication of the one of the particular sites to the server (see at least: col. 9 lines 38-64, Fig. 10). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Fano to have included *selecting, at the portable device by the user, one of the particular sites and sending an indication of the one of the particular sites to the server* as taught by Swart in order to allow a user to locate a particular supplier of products or services to expedite the processing of a mall transaction (see at least: Swartz, col. 9 line 65-col. 10 line 3).

Regarding claims 7, 35, and 40, Fano in view of Swartz further teaches *wherein the particular sites include a plurality of stores* (see at least: Fano: col. 47 line 25-col. 48 line 26, Fig. 27; Swartz: Fig. 1-2).

9. Claims 10, 14-15, 25, 28, 30, 36, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano in view of Perkowski (US 20020194081).

Regarding claims 10, 14, 28, 36, and 41, Fano teaches all of the above and further teaches a PDA with email capabilities (see at least: col. 32 line 60-col. 33 line 6). Fano, however, does note expressly teach *providing a user of the portable device with an option of having results sent via e-mail to an e-mail address provided by the user via the portable device.* Perkowski teaches *providing a user of the portable device with an option of having results sent via e-mail to an e-mail address provided by the user via the portable device* (see at least: 0915, 0922, 0935). It would have been obvious to one of ordinary skill in the art at the time of invention to have

modified the invention of Fano to have included *providing a user of the portable device with an option of having results sent via e-mail to an e-mail address provided by the user via the portable device* as taught by Perkowski in order to o request and obtain information about a service-provider's consumer service so as to make informed/educated purchases (see at least: Perkowski, abstract).

Regarding claims 15 and 25, Fano teaches all of the above as noted and further teaches implementing speech recognition and touch sensitive displays (see at least: Fig. 26). Fano, however, does not expressly teach *wherein the processing logic is further configured to receive the selection of the at least one item when the user touches the touch screen with one of an electronic pen, a stylus, and a finger in an area where a representation of each of the at least one item is displayed on the display.* Perkowski teaches *wherein the processing logic is further configured to receive the selection of the at least one item when the user touches the touch screen with one of an electronic pen, a stylus, and a finger in an area where a representation of each of the at least one item is displayed on the display* (see at least: 0037-0038, 0092, 0122, 0124). It would have been obvious at the time of invention to have modified the invention of Fano to have included a touch-screen display as taught by Perkowski in order to allow users to easy access and display information associated with a particular consumer product by simply touching the graphical image or icon of a particular consumer product displayed on the touch-screen enabled (see at least: Perkowski, 0124).

10. Claims 16-17, 26, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano in view of Malackowski et al. (US 20030027555, herein referred to as Malackowski).

Regarding claim 16, Fano teaches all of the above and further teaches the use of a touch sensitive screen (see at least: Fig. 26). Fano, however, does not teach *wherein the processing logic is further configured to receive the selection of the at least one item when the user writes a name of the at least one item on the touch screen with one of an electronic pen, a stylus, and a finger*. Malackowski teaches *wherein the processing logic is further configured to receive the selection of the at least one item when the user writes a name of the at least one item on the touch screen with one of an electronic pen, a stylus, and a finger* (see at least: abstract, 0018, 0115). The Examiner notes that the user may dial in the item name with the keypad. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Fano to have included *wherein the processing logic is further configured to receive the selection of the at least one item when the user writes a name of the at least one item on the touch screen with one of an electronic pen, a stylus, and a finger* as taught by Malackowski in order to allow a user of a mobile wireless device to easily obtain information via an IVR by simply typing in the product name (see at least: Malackowski, 0018, 0058).

Regarding claims 17, 26, and 30, Fano teaches all of the above and further teaches the use of a touch sensitive screen (see at least: Fig. 26). Fano, however, does not teach *wherein the processing logic is further configured to receive the selection of the at least one item when the user says a name of the at least one item. Fein teaches a user selecting the title*. Malackowski teaches *wherein the processing logic is further configured to receive the selection of the at least one item when the user says a name of the at least one item. Fein teaches a user selecting the title* (see at least: abstract, 0018, 0115). The Examiner notes that the user may dial in the item name with the keypad. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Fano to have included *wherein the processing logic is further configured to receive the selection of the at least one item when the user says a name of the at least one item* as taught by Malackowski in order to allow a user of a mobile wireless device to easily obtain information via an IVR by simply speaking the product name (see at least: Malackowski, 0018, 0058).

11. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fano in view of Ogasawara (US 6386450).

Regarding claim 31, Fano teaches all of the above as noted and further teaches displaying the precise location of a customer in a shopping facility (see at least: Fig. 27). Fano, however, does not expressly teach displaying a location where each of the at least one item is located in a store. Ogasawara teaches displaying a location where each of the at least one item is located in a store (see at least: abstract, col. 1 lines 12-16, col. 4 line 40-col. 5 line 4, col. 6 lines

41-63, Fig. 8). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Fano to have included displaying a location where each of the at least one item is located in a store as taught by Ogasawara in order to provide a system that saves a customer time and money (see at least: Ogasawara, col. 2 lines 14-15).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 5938721 discloses a position based personal digital assistant
- US 20010034664 discloses a systems and methods for performing e-commerce and communications over a network
- US 20020174021 discloses an optimized shopping list process

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William J. Allen
Patent Examiner

September 7, 2006

Primary